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10/561,923	12/22/2005	Yasuhiro Maenishi	2005_1976A	3061
52349	7590	07/07/2009	EXAMINER	
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1030 15th Street, N.W.				
Suite 400 East			ART UNIT	PAPER NUMBER
Washington, DC 20005-1503			3689	
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			07/07/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/561,923	MAENISHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SHEWANA SKINNER	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 December 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/22/2005</u> .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

This communication is a First Action Non-Final on the merits. **Claims 1-22**, as originally filed, are currently pending and have been considered below.

### *Claim Objections*

1. **Claims 1-19** are objected to because of the following informalities: Examiner finds the claims as written to be excessively wordy and cumbersome making them difficult to understand and making it difficult to ascertain what applicant is claiming as the invention. Appropriate corrections are required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 16-17** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claims 16-17** recite a device that comprises units that are each non-structural elements. Subsequently, the system has no structural recitation within the claims to support it in a way that would define the system/apparatus as claimed. Systems and/or apparatuses are generally defined by their structure.

3. **Claim 7** recites the limitation "a display unit" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to "a display unit" or define "the display unit" earlier in the claim.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 1-14** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim is statutory either by showing that his claim is tied to a particular machine, or by showing that his claims transforms an article to a different state or thing. Certain considerations are applicable to analysis under either branch. First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.

The claims as recited are not tied to a particular machine and do not transform the numerical data inputted into a different state or thing. Therefore, the claims do not recite statutory subject matter.

2. **Claims 16 and 17** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A “device” is recited in the claims as comprising a collecting unit, memory unit, identifying unit and display instructing unit which are each defined within the specification in terms synonymous with software or logic where software does not fit into the four statutory classes of method, apparatus, an article of manufacture and composition of matter.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-6, 8, 10, 13-16, 18, and 20** are rejected under 35 U.S.C. 102(b) as being anticipated by *Hickle et al (US 2002/0188259)*, hereinafter “*Hickle*”.

*Hickle discloses the following as claimed:*

**Claim 1.** A method for identifying an apparatus to be recalled, comprising: collecting information items stored in an integrated circuit (IC) tag attached to an apparatus via a communication network [31]; checking the collected information items with respectively corresponding information items related to the apparatus to be recalled [32]; and identifying the apparatus to be recalled, among apparatuses, to each of which an IC tag is attached, based on a checking result and one of the information items which indicates a sending source stored in the IC tag [32].

**Claim 2.** The method for identifying an apparatus to be recalled according to claim 1, wherein the IC tag holds one or more information items related to the apparatus such as a manufacturer name, a product number and a manufacturing period, and in the checking, (i) one or more information items related to the apparatus such as the manufacturer name, the product number and the manufacturing period that are collected in the collecting are checked with (ii) one or more information items related to the apparatus to be recalled, (i) and (ii) being in a one-to-one

correspondence (*[31 and 32] where the unique identification number functions as the product number*).

**Claim 3.** The method for identifying an apparatus to be recalled according to claim 1, wherein the IC tag is attached to a printed-circuit board that constitutes the apparatus, and in the identifying, the printed-circuit board to be recalled, among printed-circuit boards, to each of which an IC tag is attached, is identified based on a checking result and one of the information items which indicates a sending source stored in the IC tag *[29 and 30]*.

**Claim 4.** The method for identifying an apparatus to be recalled according to claim 3, wherein the IC tag holds one or more information items related to a component mounted on the printed-circuit board that constitutes the apparatus such as a component manufacturer name, a component number and a component manufacturing period, and in the checking, (i) one or more information items related to the component mounted on the printed-circuit board that constitutes the apparatus such as the component manufacturer name, the component number and the component mounting period that are collected in the collecting are checked with (ii) one or more information items related to the component mounted on the printed-circuit board to be recalled, (i) and (ii) being in a one-to-one correspondence *([31 and 32] where the examiner finds information items related to a component mounted on the printed-circuit board to be nonfunctional descriptive material not functionally involved in the steps recited. The step of holding information and being in one-to-one correspondence would be performed the same regardless of the information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217*

*USPQ 401, 404, (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).*

**Claim 5.** The method for identifying an apparatus to be recalled according to claim 3, further comprising wherein the IC tag stores a component number and a mounting condition of the component that is mounted on the printed-circuit board that constitutes the apparatus, in the checking, (i) the component number and the mounting condition of the component that is mounted on the printed-circuit board that constitutes the apparatus collected in the collecting are checked with (ii) the component number and the mounting condition of the component mounted on the printed-circuit board to be recalled, (i) and (ii) being in a one-to-one correspondence (*[28, 31 and 32] where the examiner finds component number and a mounting condition of the component that is mounted to be nonfunctional descriptive material not functionally involved in the steps recited. The step of holding information and being in one-to-one correspondence would be performed the same regardless of the information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).*

**Claim 6.** The method for identifying an apparatus to be recalled according to claim 3, further comprising wherein the IC tag stores information items related to a material that deteriorates with age used for the printed-circuit board that constitutes the apparatus, in the checking, (i) the information items related to the material that deteriorates with age used for the printed-circuit board that constitutes the apparatus collected in the collecting are checked with (ii) the information items related to the material that deteriorates with age used for the printed-circuit

board to be recalled, (i) and (ii) being in a one-to-one correspondence (*[31 and 32]* where the examiner finds information items related to a material that deteriorates with age to be nonfunctional descriptive material not functionally involved in the steps recited. The step of holding information and being in one-to-one correspondence would be performed the same regardless of the information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

**Claim 8.** The method for identifying an apparatus to be recalled according to claim 1, further comprising causing the apparatus to update a firmware of the apparatus identified as the apparatus to be recalled in the identifying [32].

**Claim 10.** The method for identifying an apparatus to be recalled according to claim 8, further comprising collecting an information item indicating whether the update of the firmware has successfully finished or not via a communication network after the update (*[28, 31 and 32]* where the examiner finds “collecting an information item indicating whether the update of the firmware has successfully finished” to be nonfunctional descriptive material not functionally involved in the steps recited. The step of collecting information would be performed the same regardless of the information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

**Claim 13.** The method for identifying an apparatus to be recalled according to claim 1, wherein the collecting includes: reading information items stored in the IC tag attached to an apparatus in a non-contact manner; and collecting the read information items via a communication network [34 and 36].

**Claim 14.** A method for writing information items in an IC tag placed on a printed-circuit board, comprising writing one or more information items among a component manufacturer name, a component number and a component mounting period on the IC tag mounted on the printed-circuit board at the time when the component is mounted on the printed-circuit board. ([28, 31 and 32]).

**Claim 15.** A program causing a computer to execute: collecting information items stored in an IC tag attached to an apparatus via a communication network; checking the collected information items with respectively corresponding information items related to an apparatus to be recalled; and identifying the apparatus to be recalled, among apparatuses, to each of which an IC tag is attached, based on a checking result and one of the information items which indicates a sending source stored in the IC tag. [30, 32, 45, 52 and 64 where the program is software]

**Claim 16.** A device for identifying an apparatus to be recalled, comprising: a collecting unit operable to collect information items stored in an IC tag attached to the apparatus via a communication network; a memory unit operable to memorize information items related to the apparatus to be recalled; a checking unit operable to check information items collected in the collecting with respectively corresponding information items related to the apparatus to be recalled; and an identifying unit operable to identify the apparatus to be recalled, among

apparatuses, to each of which an IC tag is attached, based on a checking result and an information item which indicates a sending source stored in the IC tag [28, 30, 32, 51 and 57].

**Claim 18.** A system for identifying an apparatus to be recalled comprising: an apparatus to which an IC tag is attached [28]; a reading unit that reads information items stored in the IC tag [33]; and a device that identifies the apparatus to be recalled connected to the reading unit via a communication network [28 and 29], wherein the device that identifies the apparatus to be recalled includes: a collecting unit that collects information items [30], which are read by the reading unit, stored in the IC tag attached to the apparatus via a communication network; a memory unit that memorizes information items related to the apparatus to be recalled [57]; a checking unit that checks (i) information items collected in the collecting with (ii) respectively corresponding information items related to the apparatus to be recalled [32 and 36]; and an identifying unit that identifies the apparatus to be recalled, among apparatuses, to each of which an IC tag is attached, based on a checking result and one of information items which indicates a sending source stored in the IC tag [32].

**Claim 20.** The system for identifying an apparatus to be recalled, according to claim 18, wherein the reading unit is installed in the apparatus (*Fig 8*).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Hickle*, as applied to Claim 1, further in view of *Obradovich et al* (US 6,754,485), hereinafter "*Obradovich*".

**As per Claim 7**, *Hickle* discloses the method for identifying an apparatus to be recalled according to claim. However, it does not disclose causing the display unit to display a notification that the apparatus is the apparatus to be recalled in the case where the apparatus identified as the apparatus to be recalled in the identifying has a display unit.

*Obradovich* discloses c-mail messages that are made up of the vehicle's identification number (*col 2 lines 58-59*) where there is an interface with a display within (attached) to the vehicle (*col 10 lines 60-67*) the displays a notification when the vehicle has been for instance recalled (*col 44-57*).

Therefore, from the teaching of *Hickle*, it would have been obvious to one of ordinary skill in that art at the time the invention was made to, if the apparatus has a display, have said apparatus display the recall notification as disclosed in *Obradovich* to provide a fast and effective method of displaying when an apparatus is recalled.

3. **Claims 9-12** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Hickle et al* (US 2002/0188259), hereinafter "*Hickle*".

**As per Claim 9**, *Hickle* discloses the method for identifying an apparatus to be recalled according to claim 8 where the apparatus is not operated. However it does not explicitly disclose writing, after the update, that the firmware has already been updated on the IC tag attached to the apparatus whose firmware has already been updated.

However, it discloses where there is writing, the tag stores updated information and it would be obvious that said information would include it being updated [*33 and 34*].

**As per Claim 10** Examiner finds the “item indicating whether the update of the firmware has successfully finished or not” to be nonfunctional descriptive material not functionally involved in the steps recited. The step of collecting an information item would be performed the same regardless of the information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

**As per Claim 11**, *Hickle* discloses the method for identifying an apparatus to be recalled according to claim 8, wherein, in the updating, causing the apparatus to update the firmware of the apparatus identified as the apparatus to be recalled in the identifying at a predetermined date or time (*Hickle [51] where the due dates are the predetermined date*).

**As per Claim 12**, *Hickle* discloses the method for identifying an apparatus to be recalled according to claim 8, further comprising examining an operating status of the apparatus to which the IC tag is attached, wherein, in the updating, causing the apparatus to update the firmware of the apparatus identified as the apparatus to be recalled in the identifying when the apparatus is not operated [*46*].

4. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Hickle*, as applied to Claim 16, further in view of *Obadovich et al (US 6,754,485)*, hereinafter "*Obadovich*".

**As per Claim 17,** Hickle discloses the device for identifying an apparatus to be recalled according to claim 16. However, it does not explicitly disclose a display instructing unit operable to instruct the display unit to display a notification that the apparatus is the apparatus to be recalled in the case where the apparatus identified as the apparatus to be recalled in the identifying has a display unit.

*Obradovich* discloses a device that uses c-mail messages that are made up of the vehicle's identification number (*col 2 lines 58-59*) where there is an interface with a display within (attached) to the vehicle (*col 10 lines 60-67*) the displays a notification when the vehicle has been for instance recalled (*col 44-57*).

Therefore, from the teaching of *Hickle*, it would have been obvious to one of ordinary skill in that art at the time the invention was made to, if the apparatus has a display, have said apparatus display the recall notification as disclosed in *Obradovich* to provide a fast and effective method of displaying when an apparatus is recalled.

5.     **Claims 19 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hickle*, as applied to Claim 18, further in view of *Obradovich*.

**As per Claim 19,** *Hickle* discloses the system for identifying an apparatus to be recalled according to claim 18. However, it does not disclose wherein the device that identifies the apparatus to be recalled further includes a display instructing unit that instructs the display unit to display a notification that the apparatus is the apparatus to be recalled in the case where the apparatus identified as the apparatus to be recalled by the identifying unit has a display unit as per the limitation in claim 19.

*Obradovich* discloses a device that uses c-mail messages that are made up of the vehicle's identification number (*col 2 lines 58-59*) where there is an interface with a display within (attached) to the vehicle (*col 10 lines 60-67*) and displays a notification when the vehicle has been for instance recalled (*col 44-57*).

Therefore, from the teaching of *Hickle*, it would have been obvious to one of ordinary skill in that art at the time the invention was made to, if the apparatus has a display, have said apparatus display the recall notification as disclosed in *Obradovich* to provide a fast and effective method of displaying when an apparatus is recalled.

**As per Claim 22,** *Hickle*, according to claim 18 further in view of *Obradovich*, discloses where the apparatus is an automobile (*Fig 7, which can reasonably be a car*) and it would be obvious for the reading unit to be installed in the road area, as that is where cars are located.

6. **Claim 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hickle*, as applied to Claim 18, further in view of *Loveland* (US 2002/016108), hereinafter, “*Loveland*”.

**As per Claim 21,** *Hickle* discloses the system for identifying an apparatus to be recalled according to claim 18. However, it does not explicitly disclose the apparatus as a household appliance and the reading unit is installed in a house.

*Loveland* discloses a relates to a computer accessible system for electronically storing a model which communicates the physical attributes of an with warranty, insurance and other information relative to that structure where recall information regarding appliances in the home is given and the reader is obviously in the home as that is where home appliances are commonly located [41,42 and 46].

Therefore, from the teaching of *Hickle*, it would have been obvious to one of ordinary skill in that art at the time the invention was made to it have a household appliance as an apparatus, as disclosed in *Loveland*, as they are types of items commonly recalled.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Obradovich et al* (US 6,987,964) and *Morris* (US 2005/0275515).

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWANA SKINNER whose telephone number is (571)270-7141. The examiner can normally be reached on Monday-Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mooneyham Janice can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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